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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,928	09/15/2003	Bret M. Berry	31132.153	2720
46333	7590	07/05/2006	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN ST SUITE 3100 DALLAS, TX 75202			SNOW, BRUCE EDWARD	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/662,928

Applicant(s)

BERRY ET AL.

Examiner

Bruce E. Snow

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-53 is/are pending in the application.  
4a) Of the above claim(s) 19-53 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-18 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to the rejections in view of Simonson and Allen have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3, 14, and 18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

At least claims 2, 3 and 18 claim a "cam device". It is unclear in view of the prior art (including Ross et al), the scope of the term "cam".

Claim 14 recites the limitation "the locking device" (both occurrences). There is insufficient antecedent basis for this limitation in the claim.

### ***Allowable Subject Matter***

Claim 14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3738

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Allen (5,658,335).

Allen teaches:

16. (Currently Amended) A modular prosthetic device, comprising:

first and second end members 90 each comprising at least one receiving means 94 and at least one locking means including 44 (dividing wall) and the cam shape shown in figure 7 positioned adjacent to the receiving means, and

a prosthetic insertion device including element 70 comprising a means for slidably engaging the at least one receiving means of the first and second end members 74, the prosthetic insertion device being adapted to be releasably secured to the first and second end members by the at least one locking means of the first and second end members.

Claims 1, 4-13, 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Simonson (6,572,653).

Simonson teaches:

16. (Currently Amended) A modular prosthetic device, comprising:  
first 56 and second end members 74 each comprising at least one receiving means 66 and at least one locking means including 64, 82 positioned adjacent to the receiving means, and

a prosthetic insertion device including element 48 comprising a means for slidably engaging (fully capable of) the at least one receiving means of the first and second end members (end turns of spring 48), the prosthetic insertion device being adapted to be releasably secured to the first and second end members by the at least one locking means 64, 82 of the first and second end members.

Regarding claim 15, it is noted that the prosthetic insertion device is not being positively claimed.

Claims 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Ross et al (2003/0187506).

Ross et al teaches:

16. (Currently Amended) A modular prosthetic device, comprising:

first 14 and second end members 16 each comprising at least one receiving means (female dovetail 30b, see paragraph 0041) and at least one locking means (including friction, pin 44, see paragraph 0043 and figure 4B) positioned adjacent to the receiving means, and

a prosthetic insertion device including element (including 20, 22, 24) comprising a means for slidably engaging the at least one receiving means of the first and second end members (male dovetail), the prosthetic insertion device being adapted to be releasably secured to the first and second end members by the at least one locking means (as indicated above) of the first and second end members.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross et al (2003/0187506) in view of Fraser et al (2004/0193271).

Ross et al teaches the prosthetic device as described above including first and second end members each having a pair of flanges (female dovetail) defining a pair of slots which slidably receive a prosthetic device. The dovetail flanges extend from a first sidewall and second sidewall. Ross et al also teaches at least one retention member 44 moveable between a first and second position. However, Ross et al is unclear if the dovetail extends entirely from a first end to a second end and, therefore, is unclear as to having a back wall. Fraser et al teaches a similar prosthetic device which uses a dovetail connect to attach first and second members (see at least elements 300 of figure 7B) wherein the dovetail extends the from a first end to a second end of the device. Fraser et al also teaches the dovetail extending from a first end to a distance to short of the second end; see figure 8A. It would have been obvious to one having ordinary skill in the art to end the dovetail short of a second end as taught by Fraser et al on the device of Ross et al forming a back wall such to provide a stop between the end members and the prosthetic insertion device and better securing them together.

Regarding claims 6-8, coatings on bone contacting prosthetic devices such as hydroxyapatite and methods of applying including roughening are well know in the art (such as Simonson) and would have been obvious to one having ordinary skill in the art to having applied to the combination device of Ross et al and Fraser et al for better anchoring.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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**BRUCE SNOW**  
**PRIMARY EXAMINER**